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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/045,143 | 01/15/2002 | Jui-Chan Sung | MR929-737 | 8874 |

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| EXAMINER |
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EGAN, BRIAN P

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| ART UNIT | PAPER NUMBER |
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1772

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|-----------------|----------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/045,143 | SUNG, JUI-CHAN | |
| | Examiner | Art Unit | |
| | Brian P. Egan | 1772 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The amendment filed August 15, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the Applicant claims in newly filed claim 15 that the adhesive is separable into two portions. The originally filed specification fails to detail this feature. The only related element detailed in the specification is the statement on p.3, lines 12-14 wherein the Applicant discloses that the base plate can be cut into pieces of desired sizes when used. This statement, however, fails to make any reference to a separable feature of the adhesive.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Interpretation

2. The limitation in Claim 15 stating that “the base plate including at least one integrally formed fin extending between opposing longitudinal ends of the base plate” must be interpreted in its broadest possible sense by the Examiner. Therefore, the limitation is interpreted by the Examiner to mean that at least one fin formation is formed between the two longitudinal ends – this does not mean, however, that the fin formation need be uniformly and continuously distributed without interruption across the base plate in the longitudinal direction. A single projection (such as a hook) along the longitudinal direction still reads on the limitation as claimed by the Applicant. Therefore, if the Applicant intends to define the fin as being

uniformly and continuously distributed without interruption across the base plate in the longitudinal direction, the Examiner suggests amending the claim to include more explicit language detailing the invention as such.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 15-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed specification fails to disclose the limitation that the adhesive is separable into two portions. The only related element detailed in the specification is the statement on p.3, lines 12-14 wherein the Applicant discloses that the base plate can be cut into pieces of desired sizes when used. This statement, however, fails to make any reference to a separable feature of the adhesive. Applicant is required to cancel the new matter in the reply to this Office Action.
5. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as his invention.

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First, there is a lack of antecedent basis for the phrase “the fins” in line 10 of the claim. The claim language fails to explicitly detail that the first and second [adhesive] pieces comprise fins after being separated. All that is claimed is “at least one integrally formed fin extending between opposing longitudinal ends of the base plate” – do each of the detached adhesive pieces comprise a portion of this “at least one integrally formed fin”? Furthermore, it is unclear whether the separable [adhesive] pieces remain attached to the base plate after being separated from one another since the claimed limitation fails to state that the base plate is separable as well. Proper clarification and/or correction are required.

6. Claim 15 is further rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as his invention. The term “being” is indefinite. The Examiner suggests replacing the term “being” with “is” to facilitate clarity (i.e., a first of the two pieces *is* secured to an object and a second of the two pieces *is* secured to a supporting surface). Proper clarification and/or correction are required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 15-16 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arakawa et al. (#5,603,145).

Arakawa et al. teach an adhesive strip for suspending and hanging an object on a surface, the adhesive strip comprising a longitudinally extending base plate made of a flexible material (Col. 2, lines 57-64), multiple fins attached to one side of the base plate wherein the fins are separated and parallel from one another and extend outward (Figs. 2, 4, and 7-11), and an adhesive layer attached to the other side of the base plate so that the adhesive strip is attachable to a surface or an object (Col. 4, lines 11-20) wherein the adhesive layer is protected by a release liner (Col. 4, lines 18-20; Fig. 7, #7), whereby an object with the adhesive strip is hung on the surface with an adhesive strip (Col. 4, lines 31-33 and Col. 6, lines 63-64). Arakawa et al. further teach that the adhesive strip provides a fastening system wherein the sheet-form hook may be hooked to opposing adhesive strips comprising fastening hooks, thereby providing two separated pieces of adhesive strip material that may be interlocked with one another (Col. 4, lines 31-33). It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have hooked opposing adhesive strips comprising fastening hooks in inverted orientation to one another for the purpose of providing hooks with interlocking engagement. Furthermore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have arranged opposing adhesive strips in inverted orientation to one another, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

9. Claims 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arakawa et al. ('145) in view of Brumlik (#4,198,734).

Arakawa et al. teach an adhesive strip as detailed above. Although Arakawa et al. teach that the fins project from the surface at an angle between 10 and 80 degrees (Col. 3, lines 35-40)

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and that there are no particular restrictions on the form or size of the fins (Col. 3, lines 24-25), Arakawa et al. fail to explicitly teach fins with rough contact faces, fins with enlarged and/or capped heads at the distal end of the fin, or saw-toothed contact faces.

Brumlik, however, teach a functional equivalence between fins as taught by Arakawa et al. and fins with enlarged (capped) heads, rough contact surfaces, and saw-toothed contact faces (see Figs. 1(a-b) and 3(a-i)). Brumlik teaches the use of a capped end for the purpose of providing a contact surface with dual-action self-gripping means, the use of the saw-toothed fin for the purpose of aiding in the penetration into the receiving substrate, and the use of the rough contact face for the purpose of providing a contact surface that can grip opposing surfaces based on its surface properties rather than its physical dimensions (see Col. 4, lines 8-44). Thus, depending on the desired end product, it would have been obvious through routine experimentation to one of ordinary skill in the art at the time Applicant's invention was made to have modified the fins of an adhesive strip with functionally equivalent shapes and/or materials for the purpose of providing the adhesive strip with either dual-action self gripping means, aiding in the penetration into the receiving substrate, or providing a contact surface that can grip opposing surfaces based on its surface properties rather than its physical dimensions as taught by Brumlik.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified Arakawa et al. by using functionally equivalent fin shapes and/or materials as taught by Brumlik in order to provide the adhesive strip with either dual-action self gripping means, aid in the penetration into the receiving substrate, or

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to provide a contact surface that can grip opposing surfaces based on its surface properties rather than its physical dimensions.

10. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arakawa et al. ('145).

Arakawa et al. teach an adhesive strip as detailed above. Arakawa et al. teach the use of an adhesive layer and teach a non-limiting example wherein styrene type pressure sensitive adhesive is used (Col. 5, lines 27-29) and wherein the adhesive layer is covered by a protective layer (Col. 4, lines 18-20). Arakawa et al. fail to explicitly teach the use of glue as the adhesive layer. It is noted, however, that Arakawa et al.'s disclosure of adhesive is interpreted by the Examiner to broadly encompass all forms of adhesive and therefore includes glue. Furthermore, even if the Applicant contends otherwise, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to have selected glue as the adhesive layer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious optimization absent demonstration of unexpected results. *In re Leshin*, 125 USPQ 416.

11. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arakawa et al. ('145) in view of Bries et al. (#6,001,471).

Arakawa et al. teach an adhesive strip as detailed above. Although Arakawa et al. teach the use of an adhesive tape (Col. 5, line 29), it is unclear whether this tape is regarded as a double-sided tape as claimed by the Applicant.

Bries et al., however, teach the use of a double-sided adhesive tape for a hook-type fastener (see Abstract; see also Fig. 4). Bries et al. teach the use of a double-sided adhesive tape

for the purpose of providing a tape with sequential release which facilitates easy removal of the hook from the object or surface that it is attached to (see Abstract). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time Applicant's invention was made to have provided an adhesive strip with a double-sided adhesive tape for the purpose of providing a tape with sequential release which facilitates easy removal of the hook from the object or surface that it is attached to as taught by Bries et al.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified Arakawa et al. by using a double-sided pressure sensitive adhesive tape as taught by Bries et al. in order to provide a tape with sequential release which facilitates easy removal of the hook from the object or surface that it is attached to.

Response to Arguments

12. Applicant's arguments with respect to claims 15-28 have been considered but are moot in view of the new ground(s) of rejection.

As noted above, the Applicant's newly claimed limitations in claim 15 with regards to the integrally formed fin extending between opposing longitudinal ends is interpreted by the Examiner to mean that the fin can extend from the surface at any point between the longitudinal ends – the fin need not be continuous and uniform between the two longitudinal ends. Therefore, the prior art of record still reads on the Applicant's claimed invention.

Furthermore, even if the Applicant amends the claimed limitations to clearly define a fin that is uniformly and continuously distributed between the two ends, it is notoriously well known in the art that a uniform and continuous fin may be used, and such a fin is an improvement upon

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the prior art hook-type fasteners. The Examiner directs the Applicant's attention to the disclosure of Galkiewicz et al. in United States Patent #6,367,128 wherein Galkiewicz teach the use of parallel interlocking fins (see Figs. 1-18(a)) that are an improvement upon prior art hook-type fasteners (Col. 1, lines 34-41).

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 703-305-3144. The examiner can normally be reached on M-F, 8:30-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 703-308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


BPE 10/22/03


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

10/31/03